Remarks

Claims 1, 5, 7, 8, 10-12, 17, 18, 20, and 21 stand rejected and remain pending. Claims 2-4, 6, 9, 13-16, 19, and 22-27 were canceled in previous responses. No claims are amended herein. The Applicant respectfully traverses the rejections and requests allowance of claims 1, 5, 7, 8, 10-12, 17, 18, 20, and 21.

Claim Rejection under 35 U.S.C. § 112, First Paragraph

Claims 1 and 12 stand rejected under 35 U.S.C. § 112, first paragraph, for failing to comply with the written description requirement. (Page 2 of the Office action.) The Office action indicates that the clause "wherein the insertion point comprises data indicating where in the selected video content the selected video advertising is to be inserted" was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventors had possession of the claimed invention at the time the application was filed. (Id.) In referring to page 6, line 25, to page 7, line 9, the Office action asserts that "the specification teaches an insertion point where the advertisement is to be inserted. In light of applicant's invention the insertion point itself indicated that the advertisement is to be inserted in the insertion point. This is different than the insertion point including data which indicated where the advertising is to be inserted." (Page 3 of the Office action.)

The Applicant respectfully disagrees with the limited interpretation of the specification proffered in the Office action. With respect to Fig. 2, the present application indicates that a requested selection of video content 201 is transferred over one transport system 202 to a scheduler 212, while advertising selected by the processing system 211 in response to the request is transferred over another transport system 204 to video storage 214. (See page 6, lines 9-11, 12-14, 19, and 20.) "The processing system 211 also determines insertion points in the selected video content 201 for the selected video advertising 213. *The processing system 211 transfers the insertion points to the scheduler 212 over* either the transport system 202, or *the transport system 204 through storage 214 and link 215*." (Page 6, lines 14-18; emphasis supplied.) As a result, the insertion points may be transported over a transport system 204 different from the transport system 202 utilized for transferring the requested selection of video content

201, as is set forth in claims 1 and 12. Thus, in that embodiment, the insertion points are more than just the points themselves within the video content at which the video advertising is to be inserted since the insertion points *are transported separately* from the selected video content 201.

Further, Fig. 3 of the present application indicates that the insertion points (T1, T2, …, TN) may be stored in a viewer profile *data structure 330* within the processing system 211. (Page 7, lines 5-9.) Thus, the insertion points of Fig. 3 are embodied as data. Additionally, "[w]hen the scheduler 212 encounters an insertion point for the selected video content 201, the scheduler 212 interrupts the transfer of the selected video content 201 and retrieves the corresponding selected video advertising 213 from the video storage 214 over the link 215. The scheduler then transfers the selected video advertising 213 to the television 221 over the link 203." (Page 6, line 27, to page 7, line 1.) Thus, the insertion points of Fig. 3 indeed "indicat[e] where in the selected video content the selected video advertising is to be inserted," as set forth in claims 1 and 12.

Thus, in light of the foregoing discussion, the Applicant contends that claims 1 and 12 are fully supported by the present application, and thus respectfully requests that the 35 U.S.C. § 112, first paragraph, rejection of claims 1 and 12 be withdrawn.

Claim Rejection under 35 U.S.C. § 103

Claims 1, 5, 7, 8, 10-12, 17, 18, 20, and 21 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 6,718,551 to Swix et al. (hereinafter "Swix") in view of U.S. Patent No. 6,698,020 to Zigmond et al. (hereinafter "Zigmond"), "NDS: NDS' XTV™ Time Shifting Technology Empowers the Viewer and the Broadcaster," M2 Presswire (Sept. 10, 1999) (hereinafter "XTV"), and U.S. Patent No. 6,588,015 to Eyer et al. (hereinafter "Eyer"). (Page 3 of the Office action.)

With respect to claims 1 and 12, the Office action indicates that Swix teaches "transferring the selected video content to a target viewer device over a first transport system and transferring the selected video advertising to the target viewer device over a second transport system, wherein the first transport system uses greater bandwidth for video transfer than the second transport system" at column 12, line 21, to column 13, line 23. (Page 3 of the Office action.) Further, the Office action indicates that Zigmond

teaches at Figs. 3-6; column 6, lines 13-29; column 7, lines 1-25; and column 17, lines 10-32, the provisions of "interrupting the transferring of the selected video content in the video stream at the insertion point; retrieving the selected video advertising from the video storage; inserting the selected video advertising into the video stream; [and] resuming the transferring of the selected video content in the video stream at the insertion point." (Page 4 of the Office action.)

However, neither Swix nor Zigmond teaches or suggests "transferring the insertion point to the target viewer device over the second transport system" (i.e., the transport system used to transfer the selected video advertising to the target viewer device), as set forth in claims 1 and 12, nor does the Office action appear to address this provision. In Swix, for example, the beginning of an insertion slot for a targeted advertisement is indicated by way of a "q-tone", which is a signal transported within a normal broadcast transmission. (Fig. 5, and column 13, lines 15-17.) Further, all signals from the cable head-end are transmitted to the various set-top boxes by way of the same distribution network. (Fig. 1; and column 4, lines 7-14.) As for Zigmond, advertisement triggers are delivered either explicitly by signal, or implicitly, by way of the normal video programming feed. (Column 8, lines 32-54. See also column 15, lines 45-65.)

The Office further indicates that Swix teaches an insertion point comprising "*data* indicating where in the selected video content the selected video advertising is to be inserted," as provided for in claims 1 and 12, specifically by way of Fig. 5 of Swix, and indicating that "the slots are indication[s] of where the advertisements are to be inserted." (Page 4 of the Office action.) However, the Applicant respectfully asserts that the advertising slots 516 themselves do not indicate where in the selected video content the selected video advertising is to be inserted. That functionality is borne by the q-tone *signals* noted above that accompany the normal broadcast transmission, and thus are not data and are not transported over a separate transport system, as set forth in claims 1 and 12. Similarly, Zigmond provides either a triggering signal or implies the timing of the trigger in its programming feed, as discussed above.

Therefore, based on at least the foregoing discussion, the Appellant contends that claims 1 and 12 are allowable in view of the combination of Swix, Zigmond, XTV, and Eyer, and such indication is respectfully requested.

Dependent claims 5, 7, 8, 10, and 11 depend from independent claim 1, and claims 17, 18, 20, and 21 depend from independent claim 12, thus incorporating the provisions of each of these independent claims. Therefore, the Appellant asserts that claims 5, 7, 8, 10, 11, 17, 18, 20, and 21 are allowable for at least the same reasons as those presented above in support of claims 1 and 12, and such indication is respectfully requested.

Therefore, in view of the foregoing discussion, the Appellant respectfully requests withdrawal of the 35 U.S.C. § 103(a) rejection of claims 1, 5, 7, 8, 10-12, 17, 18, 20, and 21.

Conclusion

Based on the above remarks, the Appellant submits that claims 1, 5, 7, 8, 10-12, 17, 18, 20, and 21 are allowable. Additional reasons in support of patentability exist, but such reasons are omitted in the interests of clarity and brevity. The Appellant thus respectfully requests allowance of claims 1, 5, 7, 8, 10-12, 17, 18, 20, and 21.

The Applicant believes no fees are due with respect to this filing. However, should the Office determine fees are necessary, the Office is hereby authorized to charge Deposit Account No. 21-0765 accordingly.

Respectfully submitted,

Date: 03/11/2009

/Kyle J. Way/

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